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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,875	12/17/2001	Tsuyoshi Kano	7217/66060	2738
7590 01/23/2006				
COOPER & DUNHAM LLP 1185 Avenue of the Americas New York, NY 10036		EXAMINER VAN HANDEL, MICHAEL P		
		ART UNIT PAPER NUMBER		
		2617		
DATE MAILED: 01/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/021,875	Applicant(s) KANO ET AL.	
	Examiner Michael Van Handel	Art Unit 2617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1, 8, 16, 26, 34, 52** are rejected under 35 U.S.C. 102(e) as being anticipated by Menard et al (US 6,810,526).

Referring to claims **1, 8, 16, 26, and 34**, Menard et al. discloses a receiver/information processing terminal/method of storing/transferring additional information, comprising the steps of:

- receiving additional information obtained and transferred by a receiver receiving a broadcast in which the additional information is multiplexed with main information including one of an audio signal and a video signal (col. 1, l. 23-25)(Fig. 1);
- determining whether preset key information is included in the additional information (col. 1, l. 25-33)(col. 2, l. 9-13)(Fig. 2);
- transferring the additional information to an information processing terminal when the key information is included; and

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- storing the additional information in a storage medium when the preset key information is determined to be included (col. 3, l. 26-28, 40-47).

3. Claims **40**, **46** are rejected under 35 U.S.C. 102(e) as being anticipated by Menard et al. (US 6,061,056).

Referring to claims **40** and **46**, Menard et al. discloses a method of transferring additional information, comprising the steps of:

- transmitting to a first information processing terminal additional information obtained by a receiver receiving a broadcast in which the additional information is multiplexed with main information including one of an audio signal and a video signal (col. 4, l. 54-58);
- determining on said first information processing terminal 1 whether key information preset in said first information processing terminal is included in the transmitted additional information; and
- transferring the additional information from said first information processing terminal to a second information processing terminal 8 at a destination when the key information is determined to be included (col. 6, l. 52-65)(Figs. 1-3).

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benyamin et al. in view of Marko et al.

Referring to claims 1, 8, 16, 26, 34, 40, 46, and 52, Benyamin et al. discloses a receiver/information processing terminal/method of storing/transferring additional information, comprising the steps of:

- receiving additional information obtained and transferred in which the additional information is multiplexed with main information including one of an audio signal and a video signal (col. 8, l. 4-13)(col. 14, l. 28-46)(Fig. 13);
- determining whether preset key information is included in the additional information (col. 14, l. 47-49);
- transferring the additional information to an information processing terminal (selected device) when the key information is included (col. 13, l. 30-32); and
- storing the additional information in a storage medium when the preset key information is determined to be included (col. 14, l. 49-51)(col. 13, l. 33-34).

Benyamin et al. does not disclose that the additional information is obtained and transferred by a receiver receiving a broadcast. Marko et al. discloses a receiver that receives content comprising auxiliary information (col. 4, l. 24-27, 36-46)(col. 5, l. 41-51)(Fig. 1)(Fig. 6). Marko et al. further discloses storing the content on a storage medium from which it is transferred to a device (the examiner notes that the content could be transferred to the computer 124 of Benyamin et al. and that Benyamin et al. discloses multiple methods of acquiring content (Benyamin et al. col. 8, l. 4-11))(Marko et al. col. 7, l. 16-22)(Fig. 7). It would have been obvious to one of ordinary

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skill in the art at the time that the invention was made to modify Benyamin et al. to receive broadcast content such as that taught by Marko et al. in order to record a composite data stream and retrieve selected content therefrom (Marko et al. col. 2, l. 43-45).

Referring to claim 46, Benyamin et al. further discloses that the technology for creating and updating play lists can be implemented on other devices (the examiner notes that the technology could be included on the receiver of Marko et al. The tracks satisfying the playlist criteria would then be transferred to pc 124 and finally to the selected device.)(col. 17, l. 61-67).

Referring to claims 2, 9, 17, 27, 35, 39, 41, 47, and 53, Benyamin et al. discloses a receiver/information processing terminal/method of storing/transferring additional information, wherein when the additional information includes a data portion consisting of a payload and a header portion consisting of information associated with the payload, information included in the header portion of the additional information is set as the key information, and when the key information is included in the header portion, the additional information including the header portion is stored in the storage medium (col. 14, l. 49-51)(col. 13, l. 33-34).

Referring to claims 3, 10, 18, 28, 36, 42, 48, and 54, Benyamin et al. discloses a receiver/information processing terminal/method of storing/transferring additional information, wherein when the additional information includes a data portion consisting of a payload and a header portion consisting of information associated with the payload, information included in the header portion of the additional information is set as the key information, and when the key information is included in the header portion, the data portion associated with the header portion is stored in the storage medium (this limitation is taught by the citation noted in claim 2 above).

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Referring to claims **4, 11, 19, 29, 37, 43, 49, and 55**, Benyamin et al. discloses a receiver/information processing terminal/method of storing/transferring additional information, wherein said step of storing/transferring stores/transfers, in addition to the additional information including the key information, the main information of the associated program in the storage medium (this limitation is taught by the citation noted in claim 2 above).

Referring to claims **5, 20, 38, 44, 50, and 56**, Benyamin et al. discloses an information processing terminal/method of storing additional information, wherein said step of storing stores accompanying information in association with the additional information (this limitation is taught by the citation noted in claim 2 above).

Referring to claims **6, 12, 21, 30, 45, and 51**, the combination of Benyamin et al. and Marko et al. discloses a receiver/method of storing/transferring additional information, wherein said receiver also receives further information of a program other the program being received and transfers the further additional information (Marko et al. col. 5, l. 41-51).

Referring to claims **7, 13, 22, and 31**, the combination of Benyamin et al. and Marko et al. teaches a receiver/method of storing/transferring additional information, further comprising the steps of transferring the additional information stored in the storage medium to a receiver, wherein the receiver displays the transferred additional information on a display unit thereof (the examiner notes that Marko et al. teaches playing back content on the receiver)(col. 6, l. 11-18)(col. 7, l. 47-51).

Referring to claims **14, 23, and 32**, the combination of Benyamin et al. and Marko et al. teaches a receiver/method of transferring additional information, wherein a step of determining stores additional information in a storage means when it is determined that the key information is

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included (col. 14, l. 49-51)(col. 13, l. 33-34). Benyamin et al. further discloses automatically updating playlists by use of a trigger when tracks are made accessible (col. 15, l. 1-14, 17-19, 23-27). The combination of Benyamin et al. and Marko et al. does not teach a step of transferring that transfers the additional information to an external device at a predetermined timing. The examiner takes Official Notice that it is well known within the prior art to trigger the transfer of data such that the transfer takes place at a predetermined time. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the trigger of Benyamin et al. in the combination of Benyamin et al. and Marko et al. to transfer data at a predetermined time such as that taught by the prior art in order to limit the consumption of processing resources.

Referring to claims **15**, **25**, and **33**, the combination of Benyamin et al. and Marko et al. teaches a receiver/method of transferring additional information, wherein a step of determining stores additional information in a storage means when it is determined that key information is included (col. 14, l. 49-51)(col. 13, l. 33-34). The combination of Benyamin et al. and Marko et al. does not teach a step of transferring that deletes the additional information from the storage means after the additional information has been transferred. The examiner takes Official Notice that it is well known within the prior art to delete data from storage after the data has been transferred (cutting and pasting files, for example). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the method of transferring files taught by the combination of Benyamin et al. and Marko et al. to include deleting data from storage after the data has been transferred such as that taught by the prior art in order to free up more memory space.



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Referring to claim 24, the combination of Benyamin et al. and Marko et al. teaches a method of storing additional information. Benyamin et al. further discloses transferring tracks to a selected device in response to a trigger (col. 13, l. 29-34)(col. 15, l. 1-14, 17-19, 23-27). The combination of Benyamin et al. and Marko et al. does not teach a step of transferring that transfers additional information in response to a transfer request. The examiner takes Official Notice that it is well known within the prior art to download data to a receiving device in response to a transfer request from the device. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the method of transferring files taught by the combination of Benyamin et al. and Marko et al. to include triggering the transfer of files in response to a download request from the selected device such as that taught by the prior art in order to ease the transfer of files from a device that is at a remote location from the receiving device.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571.272.5968. The examiner can normally be reached on Monday-Friday, 8:00am-5:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571.272.7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Van Handel  
Examiner  
Art Unit 2617

MVH

  
**CHRIS KELLEY**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**